

REMARKS

Claims 2, 4, 36-51 and 63-74 are pending in this application, have been rejected, and have been maintained unchanged. Claims 36, 43, 51, 63 and 74 are independent.

The Examiner is thanked for the telephonic interview conducted on August 14, 2007. This Response has been prepared in accordance with the discussion during that interview. The claims have been maintained without change, and arguments have been presented corresponding to the discussion with the Examiner during the interview.

To date, Applicant has not received an Interview Summary detailing the interview. To memorialize the interview, Applicant wishes to point out that the claimed invention was summarized and, as explained in detail below, the cited Toohy reference was shown not to suggest the invention due at least to the features of the invention involving link information.

The Double-Patenting Rejections

Claims 36, 43, 51, 63, 66 and 74 have been provisionally rejected on the grounds of nonstatutory double patenting over claims 54, 71 and 84 of copending application no. 09/630,557. This rejection is a nonobviousness-type double patenting rejection based upon In re Schneller, as discussed at M.P.E.P. § 804(II)(B)(2).

Claims 36, 43, 51, 63, 66 and 74 have been provisionally rejected on the grounds of nonstatutory double patenting over claims 1, 3, 66 and 77 copending application no. 09/786,208. This rejection is a nonobviousness-type double patenting rejection based upon In re Schneller, as discussed at M.P.E.P. § 804(II)(B)(2).

Applicant respectfully submits that both of these Schneller double patenting rejections are improper in view of M.P.E.P. § 804(II)(B)(2), which states such rejections are rare, and that Schneller should be limited to its facts.

The decision in In re Schneller did not establish a rule of general application and thus **is limited to the particular set of facts set forth in that decision**. The court in Schneller cautioned 'against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.' Schneller, 397 F.2d at 355, 158 USPQ at 215. **Nonstatutory double patenting rejections based on Schneller will be rare.** The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on Schneller. If an examiner determines that a double patenting rejection based on Schneller is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

This case does not present the same facts as Schneller; the claims are directed to different inventions, and Applicants are not seeking to augment the scope of protection beyond that of an issued parent case.

Nor would an obviousness-type double patenting rejection be proper. As pointed out during the interview, the claims in this application include features that are not suggested by the claims of either of the cited applications.

Lastly, the provisional nature of these rejections is noted. At this time, no further response is necessary.

Favorable reconsideration and withdrawal of these rejections are respectfully requested.

**The Rejections Under
35 U.S.C. § 103(a)**

Claims 2, 4, 36-41, 43-48, 50, 51, 63-68, 70, 71, 73 and 74¹ have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,405,176 to Toohey in view of U.S. Patent No. 6,332,133 to Takayama. Applicant respectfully traverses this rejection and submits the following arguments in support thereof.

As explained during the telephonic interview, one aspect of the claims is that link information including transaction ID information is set up and transmitted to a paying terminal upon receipt of information regarding the transaction transmitted by a paying terminal. After receiving both the same transaction ID information and a signal in response to the link information from the paying terminal synchronization of communication between the paying terminal and a virtual register one-to-one are established.

Only by way of example, and not limitation, the aspects of this invention involving link information will be particularly clear in view of portions of the disclosure such as the specification at page 23, lines 4-20, and page 30, lines 5-32.

Next, the claimed invention will be summarized (the scope of the claims is, of course, determined by the language of the claims themselves). Only pertinent portions of the claims are mentioned here.

Claim 36 involves an electronic settlement system for setting up a transaction through a communication network. This claim provides in part that a synchronizing server sets up link information including transaction ID information in association with a virtual register and transmits the link information to a paying terminal upon receipt by the synchronizing server of information regarding the transaction transmitted by the paying terminal. The synchronizing

¹ The reference in the Office Action to cancelled claim 75 clearly is in error.

server establishes a synchronization of communication between the paying terminal and virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal.

Claim 43 describes an electronic settlement server system for setting up a transaction through a communication network. Among the features of this claim is a processing unit for communicating with a paying terminal and virtual register through a communicating section, the processing unit setting up link information including transaction ID information in association with the virtual register and transmitting the link information which is indicatable in the information indicating unit of a paying terminal upon receipt of the information regarding the transaction transmitted by the paying terminal. The processing unit establishes synchronization of communication between the paying terminal and virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal.

Claim 51 concerns a recording medium which stores a program. Among the features of the program is a processing module for communicating with a paying terminal and virtual register through a communicating section, the processing module setting up link information including transaction ID information in association with the virtual register and transmitting the link information which is indicatable in the information indicating unit of a paying terminal upon receipt of the information regarding the transaction transmitted by the paying terminal. The processing module establishes a synchronization of communication between the paying terminal and virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal.

Claim 63 is directed to an electronic settlement server system. Among the features of this claim is a processing unit that sets up link information including transaction ID information in every transaction and transmits the link information which is indicatable in the information indicating unit of a paying terminal, upon receipt of information regarding the transaction transmitted by an order-receiving unit through a communicating section. The processing unit establishes a synchronization of communication between the paying terminal and virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal.

Claim 74 involves a recording medium which stores a program for a computer. Among the features of this claim is a processing module for setting up link information including transaction ID information in every transaction and transmitting the link information which is indicatable in the information indicating unit of a paying terminal upon receipt of the information regarding the transaction transmitted by an order-receiving unit. The processing module establishes a synchronization of communication between a paying terminal and a virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal.

As pointed out during the telephonic interview, Toohey fails even to suggest link information, much less use of link information in the manner claimed. Toohey merely teaches a system by which a shopper can visit an electronic shopping "mall" and purchase items from multiple "stores" in the "mall" with a single payment operation (processing not visible to the purchaser distributes payment to the appropriate "stores"). Toohey does not suggest the claimed link information or use of link information as claimed, first by being sent to the paying terminal

and then being returned from the paying terminal to the synchronizing server/processing module to identify and confirm the particular transaction that is taking place.

In fact, these differences between the claimed invention and Toohey were pointed out previously in the Amendment filed on March 5, 2007. There it was noted that Toohey merely relates to a system for shopping at an electronic "mall", in which a customer can use a virtual shopping basket to purchase items from more than one merchant at the mall and pay for those items in a single mall checkout event (Office Action, col. 4, lines 19-34). Discussing its invention, Toohey states:

In accordance with the inventive arrangements multiple store-level electronic shopping carts ['virtual ledgers'] are processed in an E-commerce mall ['mall']. The concept of the electronic shopping cart is extended to increase processing flexibility for mall participants ['electronic commerce shoppers'] by the creation of an electronic shopping basket for a mall that can contain within it virtual ledgers respectively associated with all stores in the mall. The subject invention enables implementors to process all virtual ledgers at the mall-level without sacrificing the collection of purchase data for each store-level transaction, typically associated with the processing of the virtual ledger at the store-level. This scheme is consistent with modern business processes, such as monetary transactions and inventory tracking, which are dependent upon the electronic shopping cart paradigm and are triggered upon a store-level checkout. Thus, a particular advantage of the present invention is that electronic commerce shoppers are provided with the convenience of the single payment transaction for all shopping in the virtual mall, and at the same time, the virtual stores can receive data to update respective point of sale systems.

(col. 2, lines 5-26). Neither here nor elsewhere does Toohey mention improving transaction security, much less doing so in the manner now claimed.

The Office Action is in error at page 6, insofar as the Office Action contends that Toohey suggest a processing unit that transmits link information and establishes synchronization

upon receipt of both the same transaction ID information and a signal in response to the link information from the paying terminal. Nowhere does Toohey teach this.

Toohey is contrary to and does not at all relate to the claimed invention, which, through use of the synchronizing server, does not have direct communication between the paying terminal and the virtual register.. At col. 3, line 36-38 and col. 3, line 57, through col. 4, line 3, Toohey teaches that the electronic commerce shopper communicates directly with the store (since the disclosure describes exiting the shop and then later exiting the mall, it is clear the shop and mall are different). This means Toohey has just such direct communication.

The Office Action also **admits** Toohey does not teach use of a transaction ID, and looks to Takayama to remedy Toohey's deficiencies. However, regardless of whether Takayama teaches the transaction ID, it remains that Takayama does not teach the aspects of the invention discussed above with regard to the link information.

The combination of Toohey and Takayama suffers from the same deficiency involving the link information as Toohey alone, meaning the claimed invention is patentable over this combination of references.

Also, as explained in the previous Amendment and as will now be repeated, Takayama does not even suggest the use of a transaction ID as claimed. While Takayama mentions the storage of a transaction number 2616/2620, this still does not suggest the present invention because Takayama's transaction number is not generated or used in the manner claimed. Takayama's transaction number merely serves to "uniquely represent[] a deal with the user, and it is issued by the credit settlement terminal 300 when it generates the payment offer response 609" (col. 71, lines 33-35). For the following reasons, this differs from and does not suggest the present invention.

Takayama's credit settlement terminal 300 (Fig. 3) is part of the merchant's business system (Fig. 3), and as such, is comparable to the virtual register of the present invention. So in Takayama the virtual register, not the synchronizing server, identifies the transaction.

Also, Takayama teaches that the transaction number is generated well after purchasing has begun. Takayama, as noted above, states the transaction number is issued at the time of the payment offer response 609. As shown in Fig. 6, this occurs long after the purchase transaction has begun. So Takayama does not suggest transaction ID information as claimed, which is used by the system's synchronizing server to verify that the paying terminal and virtual register are participating in the same transaction prior to the transaction taking place.

Takayama fails to suggest that the paying terminal sends two types of information to the transaction apparatus, namely, the link information and the transaction ID information. At best, Takayama suggests that the transaction number 2616/2620 is recorded by the credit settlement terminal, not to authenticate the purchaser, but merely to identify the transaction (such identification could appear, for example, on the customer's monthly credit card statement). That is, Takayama fails to suggest that the paying terminals sends back to the synchronizing server the transaction ID information and a signal from the paying terminal in response to the link information sent to the paying terminal.

Rather, Takayama's transaction number is simply information kept at the credit settlement terminal, which as noted above is comparable to the virtual register of the present invention. In this regard, it should be noted that (1) Takayama's transaction number 2616 is part of sales list 2509, (2) sales list 2509 is part of the data management information 2505, (3) data management information 2505 is part of RAM 2402, and (4) RAM 2402 is part of the credit settlement terminal 300 (Figs. 24A-26; col. 66, lines 40-49; col. 70, line 46, through col. 71, line 40).

The differences between how Takayama and the present invention provide transaction numbers is important. The claimed invention offers greater security, since the transaction number is generated by the synchronizing server. In contrast, Takayama generates the transaction ID at the credit settlement device/virtual register, which it will be appreciated could be less secure.

Applicant therefore respectfully submits that, for all the foregoing reasons, neither Toohey nor Takayama, nor the combination thereof, suggests at least the aspects of the claimed invention relating to the link information and use of the link information, or the transaction ID information.

Claims 42, 49 and 69 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Toohey in view of Takayama as applied to claims 36, 43 and 63, and further in view of what the Office Action characterized as "Official Notice" regarding what is allegedly old and well-known in the art. Specifically, the Office Action contends it is old and well-known for merchants to provide a consumer with a catalog reference number (i.e., printed on the catalog) or to identify to a consumer a reference number associated with a particular promotion or advertisement for the purpose of tracking merchant sales activities and/or to offer purchasing incentives associated with the reference number as a consequence of a purchasing transaction. Applicant respectfully traverses this rejection and submits the following arguments in support thereof.

Claims 42, 49 and 69 respectively depend from claims 36, 43 and 63, and so incorporate by reference all the features of those claims, including the features which have just been shown to avoid Toohey and Takayama.

Even assuming *arguendo* that the Office Action is correct, and the Official Notice subject matter is indeed known, that Official Notice subject matter still fails to even suggest the aspects of the claimed invention previously shown to avoid Toohey and Takayama.

Consequently, the combination of Toohey, Takayama and the Official Notice subject matter suffers from the same deficiencies as Toohey and Takayama alone. Claims 42, 49 and 69 therefore patentably distinguish over the combination of these references for at least the same reasons that claims 36, 43 and 63 avoid Toohey and Takayama, which reasons have been set forth above.

Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request entry of this Response After Final Rejection and submit that entry of this Response will place the present application in condition for allowance.

Applicants respectfully submit that all outstanding rejections have been addressed and are now either overcome or moot. Applicants further submit that all claims pending in this application are patentable over the prior art. Accordingly, favorable consideration and prompt allowance of this application are respectfully requested.

No fees are believed to be due in connection with the filing of this paper. Nevertheless, should the Commissioner deem any additional fee(s) to be now or hereafter due in connection with this application, authority is given to charge all such fees to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

Respectfully submitted,

/David L. Schaeffer/

David L. Schaeffer
Registration No. 32,716
Attorney for Applicant
Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, New York 10038
(212) 806-6677